



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Reinhold OTT

Application No.: 10/532,231

Examiner: Shirley Lu

Filed: January 18, 2006

Docket No.: 40770-000164/US

For: RETAINING COMPONENT FOR SECURING ITEMS

BRIEF ON APPEAL

Appeal from Group 2612

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I. **REAL PARTY IN INTEREST**

The real party in interest for this appeal and the present application is Reinhold Ott as this patent application has not been assigned.

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences, or judicial proceedings, known to Appellants, Appellants' representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 1-28 are pending and stand rejected.

Claims 1-28 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment was filed on September 11, 2008 to correct minor formalities and to address a rejection under 35 USC §112. Certain claims were also revised to recite a "fastening component." The Amendment was entered and the rejection of claims 1-28 was maintained in a subsequent Final Office Action mailed on October 17, 2008. No claims were amended in response to the Final Action mailed on January 16, 2009. An Advisory Action was issued on March 30, 2009 indicating that the claims remained rejected.

This brief is submitted in response to the final rejection of claims 1-28.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter of the present application relates to a retaining component for securing an item from theft, wherein the retaining component comprises a first retaining area in particular for fastening the retaining component to a fastening component, and at least one second retaining area in particular for fastening the retaining component to the item, wherein the second retaining area is designed such that it can be deformed more easily than the first retaining area, and wherein the retaining component can be attached to the item using a double-sided adhesive strip (pg 1, lines 1-7).

Independent claim 1 describes, a retaining component 1 for securing an item 2 from theft, the retaining component 1 comprising:

 a first retaining area 3 for fastening the retaining component 1 to a fastening component 4; and

 at least one second retaining area 5 for fastening the retaining component 1 to the item 2, the second retaining area 5 being designed to be more easily deformable than the first retaining area 3, wherein the retaining component 1 is attachable to the item 2 using a double-sided adhesive tape (pg. 7, lines 16-24) and includes an elastically deformable material (pg. 3, lines 11-14; pg. 7, lines 16-24), the double-sided adhesive tape being ductile (pg. 7, line 26-pg 8, line 2; Figs. 1 and 2).

Dependent claim 7 recites the retaining component 1, wherein the first retaining area 3 and the second retaining area 5 include the same material (pg. 3, lines 4-9; pg. 9, lines 7-10).

Dependent claim 24 recites the retaining component 1 as claimed in claim 12 (sensor elements for monitoring proper fastening of the retaining component 1 to the item 2 (pg. 4, lines 19-23)), wherein the sensor elements are designed as at least one of capacitive switches and optical sensor elements (pg. 4, line 19-pg 5, line 3).

Dependent claim 27 recites the retaining component 1 as claimed in claim 24, wherein electric connecting devices 6 are provided for electrically connecting the sensor elements (pg. 4, line 19- pg 5, line 3) to an evaluation circuit 7 (pg 6, lines 1-5, pg 8, lines 15-22; Figs. 1 and 2).

Dependent claim 28 recites the retaining component 1 as claimed in claim 24, wherein an evaluation circuit 7 (pg 8, lines 15-22; Figs. 1 and 2) is provided in the retaining component 1 (pg 6, lines 1-5; Fig. 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- 1) Claims 1, 7-18, 20, 22, 25 and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,556,848 to Leyden et al. (Leyden).
- 2) Claims 24, 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 5,433,391 to Jagger.

VII. ARGUMENTS

A. Claims 1, 7-18, 20, 22, 25 and 26 Are Not Anticipated By Leyden.

Claims 1, 7-18, 20, 22, 25 and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,556,848 to Leyden et al. (Leyden).

Under 35 U.S.C. §102(b), a person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. Anticipation requires that each and every element of the rejected claim is found, either inherently or expressly described in a single prior art reference (MPEP § 2131). A prior art reference that ‘almost’ meets that standard does not anticipate. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Leyden discloses a security apparatus for monitoring an article to prevent unauthorized removal of the article. In Leyden, the security apparatus 60 includes a housing 68 that contains all of the electrical components of the security apparatus 60. The housing 68 is made of a rigid material, such as a hard plastic (col. 6, lines 8-11). The apparatus 60 also includes a body 62 made of a material that can be configured into a plurality of shapes and maintain itself in the plurality of different shapes. Once the material of the body 62 is conformed to a particular article, the body will not spring back to its undeformed shape. As a result, a positive bond between the body 62 and the article 88 being protected can be maintained without fear of peeling off by reason of its own reconfiguration (col. 2, line 61-col. 3, line 4; col. 6, lines 46).

Thus, in contrast to the claimed retaining component that includes a second retaining area including an “elastically deformable material,” the body 62 is not an elastically deformable material. Rather, as clearly described in Leyden, the body 62 “once conformed...will not spring back to its undeformed state.” Thus, it appears the Examiner may be confusing the plasticity of Leyden with the elasticity of the present invention. For example, Leyden clearly describes the “conformable part of the body” 62 as being “made from a material that can be reconfigured into a plurality of shapes and maintains itself in the plurality of different shapes” (see col. 6, lines 35-39 and claim 1 of Leyden). In contrast to the “plastic” characteristics of Leyden, the device of

the present invention, and recited in the claims, is an “elastically deformable material” (i.e., a material that can return to its original shape.

1. Improper Claim Interpretation

During examination, “claims yet unpatented are to be given their broadest reasonable interpretation consistent with the specification during an examination of a patent application” (*Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), *In re Prater*, 415, F. 2d 1493 (1969)). This standard is also provided as the standard for claim interpretation under MPEP §2111 which recites that “during patent examination the pending claims must be given the broadest reasonable interpretation consistent with the specification.” The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1) (MPEP §2111).

The specification is the “primary basis for construing claims” and is the “single best guide to claim meaning” because the specification, as set forth by statute, describes the claimed invention in full, clear, concise and exact terms (*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)). According to *Phillips*, first, the claim language, specification, and prosecution history (intrinsic evidence) are the primary sources for claim construction. Second, the trial court may use other evidence, including dictionaries, treatises, and expert testimony (extrinsic evidence) to understand the technology at issue and as part of the claim construction process. Extrinsic evidence, however, may not be used to reach a claim construction that is inconsistent with the intrinsic evidence. Third, the principle that “claims should be construed to uphold their validity” has very narrow applicability.

It is alleged in the Response to Arguments section of the Final Office Action that the claimed feature of being an “elastically deformable material” is met by the prior art and that the

“broadest reasonable interpretation” is “capable for change/expansion/contraction, not rigid or constructed.” However, the Examiner failed to cite any authority for the applied definition. Therefore, the interpretation is without merit.

Moreover, the applied definition is in conflict with the description of an elastically deformable material as that term is used in the specification and as well-known in the art. For example, the specification recites that the retaining component preferably consists of an elastically deformable material (pg. 3, paragraph 2). The specification further describes that the retaining component can be adjusted to nearly any randomly rounded items due to the elastic deformation of the second retaining area (pg. 7, paragraph 3). The claimed elastically deformable retaining component is specifically distinguished from the material used in Leyden at page 2, paragraph 1 of the specification of the present application. Thus, interpreting the device of Leyden as being elastically deformable is inconsistent with the specification.

Further, from the Examiner’s interpretation of the term “elasticity” it appears that the Examiner confuses the terms elasticity and plasticity. For example, “elasticity” has a well-known definition in the art that denotes a special type of deformation, rather than the mere ability to be deformed under the effect of external forces. For example, the *Encyclopedia Britannica* describes elasticity as “enabling a solid to return to its original shape after the load has been removed.” *The American Heritage Dictionary*, 3rd Ed. defines elasticity as the property of being elastic (i.e., easily resuming original shape after being stretched or expanded; flexible). In contrast, the *Encyclopedia Britannica* describes plasticity as “enabling a solid, under the action of external forces, to undergo permanent deformation without rupture.” *The American Heritage Dictionary*, 3rd Ed. defines “plasticity” as capable of being formed or shaped; having the qualities of sculpture. Therefore, while the thermal setting rubber of Leyden used to make the device may be plastic, it is not an elastically deformable material.

As discussed above, Leyden specifically describes that the body is made of a material that can be conformed to a particular article but will not spring back to its undeformed state. These characteristics are in keeping with a goal of Leyden to prevent the body from peeling off of an article “by reason of its own reconfiguration” (col. 2, line 61-col. 3, line 2).

Thus, when properly interpreted, Leyden fails to disclose an “elastically deformable material.” Rather, as discussed, Leyden merely describes the body being “made from a material

that can be reconfigured into a plurality of shapes and maintains itself in the plurality of different shapes (i.e., plastic).

Because of this well-known difference between elastic materials and plastic materials, Leyden actually teaches away from the use of the claimed “elastically deformable material” because every embodiment of Leyden is related to a plastically deformable material that does not have a tendency to peel off (col. 6, lines 43-46). Thus, Leyden does not disclose the structural arrangement of the claims as alleged.

B. Claim 7 Is Not Anticipated By Leyden.

Claim 7 recites, in part “wherein the first retaining area and the second retaining area include the same material.”

It is alleged that Leyden discloses “the first retaining area and the second retaining area include the same material.” However, Leyden recites that the alleged first retaining area (housing 68) is made of a hard plastic to house the electrical components of the security apparatus 60. The alleged second retaining area of Leyden (body 62) is a thermal setting rubber. Thus, in contrast to the subject matter of claim 7, the first and second retaining areas of Leyden do not include the same material.

It is also alleged in the Response to Arguments section of the Final Office Action that the “first retaining area is the top area of apparatus 60 that is of the material 62, and the second retaining area is the bottom are of apparatus 60 that is of the material 62.” However, claim 7 includes the features of claim 1. Claim 1 recites that “the first retaining area” is the area for fastening the retaining component to a fastening component. Therefore, the first retaining area of Leyden must be the area 68 (housing) that houses the cord 74. As the housing 68 is clearly described in Leyden as being of a material different from the body 62, Leyden fails to disclose or suggest the features of claim 7.

C. Claim 24, 27 and 28 Are Not Rendered Obvious By Leyden and Jagger.

Claims 24, 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 5,433,391 to Jagger.

Under 35 U.S.C. §103(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a *prima facie* case of obviousness, the teaching or suggestion to combine references must both be found in the prior art, and not based on applicant's disclosure (MPEP §2142). In making an assessment of the differences between the prior art and the claimed subject matter, 35 USC § 103 specifically requires consideration of the claimed invention "as a whole." The "as a whole" instruction in § 103 prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components (*Ruiz v. A.B. Chance., Co.*, 357 F.3d 1270, 1275, (Fed. Cir. 2004)).

Jagger relates to a cereal milling machine that grinds stock stored in a hopper using grinding rolls and therefore is not related in any way to a retaining component for securing items from theft or applicable to the problem being addressed in the present application. Further, one of skill in the art would not seek to modify the theft prevention device of Leyden with the teachings of a cereal milling machine. Moreover, there is no motivation to make the combination suggested by the Examiner, nor is there any reasonable expectation of success in making the combination without the improper use of hindsight. Thus, the combination of references fails to render the rejected claims obvious.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-28 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejection of claims 1-28 and allow all pending claims.

Respectfully submitted,

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APPENDIX A – CLAIMS APPENDIX

1. Retaining component for securing an item from theft, the retaining component comprising:

a first retaining area for fastening the retaining component to a fastening component; and
at least one second retaining area for fastening the retaining component to the item, the second retaining area being designed to be more easily deformable than the first retaining area, wherein the retaining component is attachable to the item using a double-sided adhesive tape and includes an elastically deformable material, the double-sided adhesive tape being ductile.
2. Retaining component as claimed in claim 1, wherein an expansion of the double-sided adhesive tape leads to a roughly simultaneously occurring detachment of the same from the retaining component and the item.
3. Retaining component as claimed in claim 2, wherein at least one of the expansion and the detachment of the double-sided adhesive tape triggers an alarm.
4. Retaining component as claimed in claim 1, wherein the double-sided adhesive tape is equipped with a non-adhesive handling area.
5. Retaining component as claimed in claim 1, wherein the double-sided adhesive tape can be pulled off laterally.

6. Retaining component as claimed in claim 1, wherein the double-sided adhesive tape involves a product from Tesa company, which is distributed under the term Power Strip.
7. Retaining component as claimed in claim 1, wherein the first retaining area and the second retaining area include the same material.
8. Retaining component as claimed in claim 1, wherein the first retaining area and the second retaining area are an integral part of the retaining component.
9. Retaining component as claimed in claim 1, wherein the material thickness of the second retaining area is less than the material thickness of the first retaining area.
10. Retaining component as claimed in claim 1, wherein in the second retaining area an adhesive layer is provided for attaching the retaining component to the item.
11. Retaining component as claimed in claim 1, wherein the attachment of the retaining component to the fastening component is detachable.
12. Retaining component as claimed in claim 1, wherein the retaining component comprises sensor elements for monitoring proper fastening of the retaining component to the item.

13. Retaining component as claimed in claim 1, wherein the sensor elements are designed as electric sensor elements.
14. Retaining component as claimed in claim 12, wherein electric connecting devices are provided for electrically connecting the sensor elements to an evaluation circuit.
15. Retaining component as claimed in claim 12, wherein an evaluation circuit is provided in the retaining component.
16. Retaining component as claimed in claim 1, wherein mechanical connecting devices are provided for connecting the retaining component to the fastening component.
17. Retaining component as claimed in claim 16, wherein the connecting devices are designed as wires or cables.
18. Retaining component as claimed in claim 14, wherein the connecting devices are integratable in the fastening component.
19. Retaining component as claimed in claim 18, further including a fastening component connected to the retaining component, wherein the fastening component includes a winding device for the connecting devices.

20. Retaining component as claimed in claim 14, further including a fastening component connected to the retaining component, wherein the evaluation circuit is arranged in the fastening component.
21. Retaining component as claimed in claim 19, further including a fastening component connected to the retaining component, wherein the electric connecting devices are contactable via ball contacts in the winding device.
22. Alarm system comprising a retaining component as claimed in claim 1 and a fastening component for fastening the retaining component.
23. Retaining component as claimed in claim 1, wherein the double-sided adhesive tape can be pulled off laterally using a force that is applied on the adhesive tape and that acts upon it roughly in the plane of the adhesive tape.
24. Retaining component as claimed in claim 12, wherein the sensor elements are designed as at least one of capacitive switches and optical sensor elements.
25. Retaining component as claimed in claim 13, wherein electric connecting devices are provided for electrically connecting the sensor elements to an evaluation circuit.
26. Retaining component as claimed in claim 13, wherein an evaluation circuit is provided in the retaining component.

27. Retaining component as claimed in claim 24, wherein electric connecting devices are provided for electrically connecting the sensor elements to an evaluation circuit.

28. Retaining component as claimed in claim 24, wherein an evaluation circuit is provided in the retaining component.

APPENDIX B – EVIDENCE APPENDIX

None

APPENDIX C – RELATED PROCEEDINGS APPENDIX

None